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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,912	10/15/2003	William Fiehler	47563.0011	6302
57600	7590	06/12/2007		
HOLLAND & HART LLP 60 E. SOUTH TEMPLE SUITE 2000 SALT LAKE CITY, UT 84111			EXAMINER POUS, NATALIE R	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 06/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/685,912

Applicant(s)

FIEHLER ET AL.

Examiner

Natalie Pous

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/25/05, 12/29/03</u> .                                      | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

### *Response to Arguments*

#### **Regarding the Claim Objections**

Examiner acknowledges amendment to claim 35 to correct claim dependency.

The previous objection to claim 35 is withdrawn

#### **Regarding the claim rejections**

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection based on amendments to the claims. However, examiner asserts that Nash teaches all limitations of amended independent claims 1 and 31. Applicant argues that Nash fails to teach wherein force generated by withdrawal of the closure device tamps the sealing plug. Examiner respectfully disagrees. As described in paragraph 7, proximate lines 33-35, Nash states "in fact, continued retraction causes the filament to somewhat deform the plug, i.e. cause it to deform radially outward." Thus, it is the force generated by the withdrawal of the closure device that tamps the sealing plug. Since the claim language indicates a tissue puncture closure device **comprising** the elements listed, it is not necessary that this be the only means of tamping.

#### **Regarding the provisional double patenting rejections**

The terminal disclaimer filed on 3/21/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of application 11/103196 has been reviewed and is accepted. The terminal disclaimer has been recorded.

However the previous provisional patenting rejection with respect to applications 11/130895, 11/130688, 11/103730, 11/103257 are still outstanding. Examiner acknowledges applicants remarks with respect to these applications, however examiner points out that this is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 14, 31, 32 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Nash et al. (US 5662681).

Regarding Claim 1, Nash teaches a tissue puncture closure device for partial insertion into and sealing of an internal tissue wall puncture comprising: a filament (34) extending from a first end of the closure device to a second end of the closure device; an anchor (32) for insertion through the tissue wall puncture attached to the filament at the second end of the closure device; a sealing plug (30) slidably attached to the filament adjacent to the anchor (fig. 2); an automatic driving mechanism (36) for automatically tamping or cinching the sealing plug

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toward the second end upon withdrawal of the closure device from the internal tissue wall puncture (fig. 3).

Regarding Claim 14, Nash teaches the device of claim 1, wherein the filament extends at least partially back toward the proximal end and re-engages the seal plug (fig. 2).

Regarding Claim 31, Nash teaches a method of sealing a puncture in an internal tissue wall accessible through a percutaneous incision, comprising; withdrawing a closure device from the tissue puncture; automatically transducing a motive force generated by withdrawal of the closure device in a first direction to or tamping force in a second direction (Column 7, proximate lines 28-36).

Regarding Claim 32, Nash teaches the method of claim 31, further comprising applying the tamping force in the second direction to a sealing plug (30).

Regarding Claim 39, Nash teaches a method of sealing a tissue puncture in an internal tissue wall accessible through a percutaneous incision comprising: providing a tissue puncture closure device comprising a filament (34) connected at its distal end to an anchor (32) and to a sealing plug located proximal of the anchor for disposition and anchoring about the tissue puncture; inserting the tissue puncture closure into the percutaneous incision; deploying the anchor; withdrawing the closure device from the percutaneous; automatically tamping the sealing plug toward the anchor end upon withdrawal of the closure device from the internal tissue wall puncture (Columns 5-7).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of copending Application Nos. 11/130895, 11/130688, 11/103730 and 11/103257. Although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to the same inventive concept, that being a tissue puncture closure device comprising a filament, an anchor, a sealing plug and an automatic driving mechanism for automatic tamping, including a transducer, a spool, a gear, a torque limiting clutch etc.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tan-Uyen (Jackie) Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP  
5/30/07

  
(JACKIE) TAN-UYEN HO  
PRIMARY EXAMINER  
06/07/07